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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/811,143	03/29/2004	Christoph Schmidt	MERCK-2854	8474
23599	7590	10/31/2005		
MILLEN, WHITE, ZELANO & BRANIGAN, P.C. 2200 CLARENDON BLVD. SUITE 1400 ARLINGTON, VA 22201			EXAMINER GREEN, ANTHONY J	
			ART UNIT	PAPER NUMBER
			1755	

DATE MAILED: 10/31/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/811,143	<b>Applicant(s)</b> SCHMIDT ET AL.	
	<b>Examiner</b> Anthony J. Green	<b>Art Unit</b> 1755	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 12 September 2005.
- 2a) ☐ This action is FINAL.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Response to Amendment***

1. This office action is in response to the amendment submitted on 12 September 2005. Currently claims 1-14 are pending.

### ***Claim Objections***

2. Claims 6 and 7 are objected to because of the following informalities: In claims 6 and 7 the phrase "according claim 1" should be -- according to claim 1 --. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 2-8 and 10-11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The preambles of claims 2-6 are inconsistent with claim 1 as claim 1 does not positively recite "a silver pigment". Applicant needs to use consistent terminology.

Claim 7 is vague and indefinite as it is unclear as to exactly how the pigments are prepared. For instance, the claim recites "wet chemical methods" and it is unclear as to what methods are encompassed by this phrase. Also the claim recites "hydrolytic

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decomposition of metal salts” however it is unclear as to the types of metal salts encompassed by the claim. The phrase “thermal decomposition by a CVD or PVD process” is vague and indefinite as it is unclear as to what is thermally decomposed. Also this claim refers to “a silver pigment according claim 1” however claim 1 does not positively recite “a silver pigment”. Applicant needs to use consistent terminology.

Claims 10 and 11 are inconsistent with claim 1 as claim 1 does not positively recite “a silver pigment”. Applicant needs to use consistent terminology.

***Claim Rejections - 35 USC § 102/103***

5. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

6. Claims 1-10 and 12-14 are rejected under 35 U.S.C. 102(b) as being anticipated by Bauer et al WO 93/08237 for the reasons set forth in the previous office action and which are herein incorporated by reference.

Applicant argues that the instant claims are not met by the reference as the pigments of the reference does not exhibit color travel. It is the position of the examiner that since the pigment is the same that it would exhibit color travel and applicant has not provided any convincing evidence showing that the pigment of the reference does not exhibit color travel.

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7. Claims 1-10 and 12-14 are rejected under 35 U.S.C. 102(b) as being anticipated by Bauer et al US Patent No. 6,630,018 for the reasons set forth in the previous office action and which are herein incorporated by reference.

Applicant argues that the instant claims are not met by the reference (equivalent to the WO 93/08237 cited above) as the pigments of the reference does not exhibit color travel. It is the position of the examiner that since the pigment is the same that it would exhibit color travel and applicant has not provided any convincing evidence showing that the pigment of the reference does not exhibit color travel.

8. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bauer et al (WO 93/08237) in view of Herget et al US 6,270,563 for the reasons set forth in the previous office action and which are herein incorporated by reference.

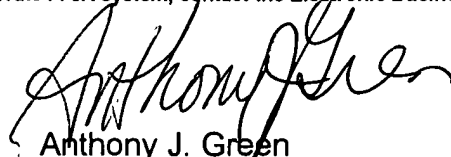
Applicant argues that the instant claim is not rendered obvious by the combination of references as the deficiencies of the Bauer et al reference are not remedied by the secondary reference. It is the position of the examiner that the instant claim is rendered obvious by the reference as applicant has not shown that the pigment of the Bauer et al reference does not exhibit color travel. Accordingly in the absence of evidence showing otherwise the instant claim is rendered obvious by the reference,

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anthony J. Green whose telephone number is 571-272-1367. The examiner can normally be reached on Monday-Thursday 6:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry Lorengo can be reached on 571-272-1233. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Anthony J. Green  
Primary Examiner  
Art Unit 1755

ajg  
October 26, 2005